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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,094	08/08/2001	Jung-Wan Ko	1293.1059-CIPD3	3341

49455 7590 01/04/2006

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EXAMINER

SHIBRU, HELEN

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/924,094	KO ET AL.	
	Examiner	Art Unit	
	HELEN SHIBRU	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/26,09/05,5/22/3</u> . | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 29-32 and 38-47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6, 810, 201.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

The subject matter of claim 1 can be found in patent claims 1, and 2. Patent claim 1 recites a playback apparatus to perform a playback operation on the storage medium which includes audio data, catalog information related to the audio data, and catalog playback information connecting the audio data and the catalog information to each other during playback, the playback apparatus comprising:

a video decoder which decodes from another region the catalog information and additional information to generate a restored image (patent claim 6 recites the playback apparatus of claim 1, wherein the restored image is a still picture for background display, and the

additional information is a sub-picture for transferring characters (caption of the present application claim 1));

an audio decoder which decodes the audio data from an audio region to generate restored audio signals; and

a controller which controls playback of the catalog information reproduced from the another region corresponding to a selection of a user (navigation information of the present application) and the catalog playback information reproduced from the audio region,

wherein:

the storage medium comprises:

the audio region which includes the catalog playback information and an audio title set (ATS) in which is stored the audio data, and

the another region which is other than the audio region and which includes the catalog information and the additional information, the another region further comprising a catalog management (CMG) region having management information on the catalog information, and a catalog title set (CTS) having the catalog information (the catalog information is stored in different region other than the audio region).

Patent claim 2 recites, a storing units common catalog data for information commonly applied for the entire audio data recorded on the storage medium and title catalog data having information corresponding to each distinct item of the audio data, and the controller reads the catalog data from the storing means in accordance with the selection from the user.

The subject matter of claim 30 can be found in patent claims 1-3, 6 and 8. Patent claim 1 recites a playback apparatus to perform a playback operation on the storage medium which

includes audio data, catalog information related to the audio data, and catalog playback information connecting the audio data and the catalog information to each other during playback, the playback apparatus comprising:

a video decoder which decodes from another region the catalog information and additional information to generate a restored image (patent claim 6 recites the playback apparatus of claim 1, wherein the restored image is a still picture for background display).

Patent claim 3 recites a storing unit which stores the catalog information obtained from the another region of the storage medium, wherein the controller reads the catalog information from the storing unit in a predetermined sequence.

Patent claim 3 recites, a controller which controls playback of the catalog information reproduced from the another region corresponding to a selection of a user and the catalog playback information reproduced from the audio region, if a user does not enter a catalog selection command for a given time during a playback mode of the audio data, the controller reads the audio presentation information table to extract the corresponding catalog information of the audio data being played back.

The subject matter of claim 31 can be found in patent claim 2.

The subject matter of claim 32 can be found in claim 1 and 6.

The subject matter of claim 38 can be found in patent apparatus claims 1, 7 and 14.

The subject matter of claim 39 can be found in Patent claim 28.

The subject matter of claims 40 and 41 can be found in Patent claims 1 and 2.

The subject matter of claims 43 and 44 can be found in claims 1 and 6.

The subject matter of claim 45 can be found in claims 1, 3, 8 and 21.

The subject matter of claim 46 can be found in Patent claims 1,2 and 8.

The subject matter of claim 47 can be found in Patent claims 1,2 and 8.

3. Claims 33-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,771,892 in view of Official Notice.

The subject matter of claim 33 can be found in Patent claim 1. Patent claim 1 recites a storage medium comprising: audio data stored in a first predetermined area of the storage medium with catalog playback information; and catalog information related to the audio data and stored in a second predetermined area of the storage medium other than the first predetermined area, wherein: the catalog information comprises a still picture, a sub-picture, and navigation information controlling the still picture and the sub-picture, the second predetermined area comprises a catalog management (CMG) region having management information on the catalog information, and a catalog title set (CTS) in which is recorded at least one title catalog of the catalog information related to each item of the audio data, and during reproduction of the audio data, the catalog information is reproduced according to the catalog playback information.

Claim 33 differ from Patent claim 1 in that the claim further requires a reproducing apparatus comprising a playback signal processing unit to read data from the storage medium.

Official Notice is given that it is well known in the art to read stored data using playback apparatus. Therefore it would have been obvious to one of ordinary skill in art at the time the invention was made to include a reproducing apparatus in order to playback the stored data from recording medium.

The subject matter of claims 34-35 can be found in Patent claims 7 or 11.

The subject matter of claim 36 can be found in Patent claim 5.

The subject matter of claim 37 can be found in claims 1 and 4.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329.

The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES J. GROODY can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru
February 2, 2006


ROBERT CHEVALIER
PRIMARY EXAMINER